

**REMARKS**

Reconsideration is respectfully requested.

Claims 1-4, currently pending in the present application, stand rejected in the Office Action. By the present amendment, Claim 2 is cancelled, and Claim 1 is amended. A marked-up copy of the amended claims is attached hereto. No new matter has been added.

Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Figs. 1-2 labeled as Prior Art of the present application in view of U.S. Patent No. 5,532,533 (Mizutani).

**Claim 1**

**Neither The Admitted Prior Art Nor the Mizutani Reference, Either Alone or in Combination, Teaches or Suggests Every Element of Claim 1, as Amended**

The Applicant claims a resin molded BLDC motor that comprises, inter alia, a control board that is disposed in a depression of the injection molded housing where the depression is formed in the injection molded housing as a part of the injection molded housing. The control board in the depression is not affected by the high temperature generated while the housing is being injection molded.

These claimed elements are clearly not admitted or suggested as a prior art in the present application since they are disclosed to overcome the problems associated with the prior art injection molded BLDC motors. The problems, for example, include damaged control boards due to the high temperature generated in the injection molding process. As understood by the Applicant, this point is consistent with the Examiner's view as stated in the Office Action, page 3.

In addition, nowhere in the Mizutani reference discloses the depression that is formed as a part of the injection molded housing of a BLDC motor. As shown in Figs. 1 and 7-10 of Mizutani, the printed circuit boards (such as 58 and 60) are encased by a combination of a cover 34, a chassis 51, etc. These separate components, which are not created by a molding process, are substantially different from the claimed depression that is formed as a part of the injection molded housing.

The Applicant respectfully submits that the Office bears the burden of showing a *prima facie* case of obviousness. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993); see *In re Fine*, 837 F.2d 1071, 1074 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). One of many requirements for establishing *prima facie* obviousness is that the prior art references must teach or suggest all claim limitations. MPEP §2143. Since this requirement has not been met by either the Mizutani reference or the admitted prior art of the present application, the Applicant respectfully submits that, at least on this ground alone, the *prima facie* case of obviousness has not been established.

**No Motivation Or Suggestion To Combine The Admitted Prior Art And The Mizutani Reference Is Found In Either Reference**

In order to combine prior art references to establish a *prima facie* case of obviousness --on this point, it has been already pointed out in the above that this requirement has not been met--the Office is required to show in the references themselves that there is some suggestion or motivation to modify references or to combine reference teachings. That is, the mere fact that the teaching of the prior art can be modified or combined does not establish a motivation or suggestion to combine and make the resultant combination *prima facie* obvious. The prior art must suggest the desirability of the combination. See MPEP §2143.

The claimed invention of the present application solves the problems associated with the known problems of the prior art BLDC motors (i.e., the circuit board is exposed to the high temperature condition of the injection molding process and may become damaged as a result). The damaged circuit board could not be serviced or replaced since the damaged circuit board is permanently encapsulated inside the mold.

The present invention solves these problems by disposing a control board in a depression formed as a part of the injection molded housing so that the control board is not affected by the high temperature generated while the housing is injection-molded. The circuit board of the present invention in the depression can be retrieved for repair or replacement, in presence of any defect. Thus, the BLDC motors of the present invention results in improved reliability and lowered costs over the prior art.

Mizutani, in contrast, does not disclose that the housing of the motor is formed by an injection molding process. Mizutani describes that separate components in a motor (such as the stator or the rotor) can be resin molded but provides different reasons for molding these components, for example, to dissipate the heat generated during the operation of the motor, not to provide a housing (Mizutani, col. 4, lines 58-62). For example, as shown in Mizutani Figs. 1 and 7-10, the resin molded stator and the rotor components are enclosed by other non-injection molded components (such as the "housing 8," "chassis 51," and "housing 51b").

Further, a circuit board of the present invention is separated from the other components, which are molded, to prevent the control board from being exposed to the heat generated during the molding process. In contrast, Mizutani suggests that "the power circuit 31, the printed circuit board 58 and the chassis 51" can be "molded integrally with resin" (Mizutani, col. 10, lines 24-27). Thus, motivation found in Mizutani leading one to provide for molding is substantially different from--if not contrary to--that disclosed in the present application.

**Further, The Examiner's Conclusive Statement Of Obviousness Without Proper Support For The Statement Is Considered To Be Improper**

It is stated in the Office Action that it would have been obvious to one of ordinary skill in the art at the time the invention was made to rearrange the board of Prior art to accommodate the control board arrangement as taught by Mizutani in order to prevent the board from heat damage.

The Applicant respectfully submits that this statement in the Office Action is simply a conclusion and does not properly state the grounds of the rejection or the reason why the proposed combination is obvious from the disclosure found in the references. This type of conclusory rejection has been found to be an improper assertion of a "conclusion, not a reason" (In re Garrett, decided on September 30, 1986; for a synopsis of In re Garrett, see the enclosed copy of BNA PTC Journal, vol. 33, page 63).

The Applicant's response to such conclusive statement of obviousness is that the basis for improperly finding the Applicant's claimed invention obvious appears to be the teaching found in this application, and not in the prior art. That is, there is no hint or suggestion in the Mizutani reference that the printed circuit boards are arranged in such a way to prevent from the heat damage during an injection molding process. As such, the obviousness rejection improperly relies on the impermissible hindsight reasoning, because the rejection would not be obvious absent the Applicant's disclosure in this application. (See also 37 C.F.R. §1.104(c)(2).)

For the reasons above, the Applicant respectfully submits that independent Claim 1, as amended, is now considered to be in condition for allowance and respectfully requests an indication thereof.

**Dependent Claims 3-4**

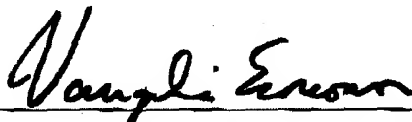
As to dependent Claims 3-4, Applicant respectfully submits that these claims are allowable at least since they are dependent on the independent Claim 1 that is considered to be allowable.

**Conclusion**

For the reasons set forth above, Applicant respectfully submits that the Claims 1 and 3-4, now pending in this application, are in condition for allowance over the cited art. This Amendment is considered to be responsive to all points raised in the Office Action. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and earnestly solicits an indication of allowable subject matter. Should the Examiner have any remaining questions or concerns, the Examiner is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,

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# BNA'S PATENT, TRADEMARK & COPYRIGHT JOURNAL

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## HIGHLIGHTS

November 13, 1986

**PRESIDENT REAGAN SIGNS INTO LAW** (P.L. 99-607) the PTO authorization bill (H.R. 2434). However, in a prepared statement, the President expressed some concerns with the measure. The limitation on the use of fee revenues for automation costs will make automation more dependent on scarce general revenues, he cautioned, and the 90-day report-and-wait provisions "come unduly close to crossing that fine line between legitimate oversight and interference in the management prerogatives of the Executive branch." page 31

**PATENT COOPERATION TREATY BILL** (S.1230) is signed into law (P.L. 99-616). The measure implements Chapter II of the Treaty through various amendments to Part IV of Title 35 of the U.S. Code. page 31

**COPYRIGHT IN BASEBALL TELECASTS** belongs to the clubs under the "work for hire" doctrine, the U.S. Court of Appeals for the Seventh Circuit holds. Further, the court rules, the clubs' copyright preempts the players' rights of publicity in their performances. "[O]nce a performance is reduced to tangible form, there is no distinction between the performance and the recording of the performance for the purpose of preemption under §301(a)," Senior Judge Eschbach declares. page 32

**SALE OF COUNTERFEIT 'ROLEX' watches** at flea markets for \$25 is actionable under the Lanham Act even though purchasers know they aren't getting the real thing. Once a product is injected into commerce, the U.S. District Court

for the Southern District of Florida reasons, there is no bar to confusion occurring at some future point in time. page 34

**DECLARATORY JUDGMENT** on "public use" issue is not appropriate, the U.S. District Court for the Middle District of North Carolina determines. The court notes that the issue is currently before the PTO, and explains that declaratory relief should not be granted where a special statutory proceeding has been provided. page 35

**TRADE ASSOCIATION HAS STANDING** to sue on behalf on its members under §43(a) of the Lanham Act to enjoin the sale of mislabeled products, the U.S. Court of Appeals for the First Circuit concludes. page 36

**CONVICTION FOR CRIMINAL COPYRIGHT** infringement based on the alleged unlawful distribution of copies of audiovisual works is reversed by the U.S. Court of Appeals for the Eleventh Circuit. The government, the court observes, presented no evidence to rebut the defendant's testimony that the copies were the subject of a "first sale." page 37

**EMPLOYER HAS RIGHT TO INVENTION** under an assignment agreement if the invention comes within the scope of the employer's business or resulted from work the employee did for the employer, the California Court of Appeal (Fourth Appellate District) decides. page 38

This issue contains pages 31-45.

## NEWS &amp; COMMENT

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of trade secrets, plaintiff accused the defendants of violating and conspiring to violate RICO, 18 USC 1962(c)(d). The defendants moved to dismiss for failure to state a claim upon which relief may be granted.

To state a civil cause of action under RICO, Chief Judge Pratt explains, plaintiff must allege: (1) conduct (2) of an enterprise (3) through a pattern (4) of "racketeering activity" which has caused injury to plaintiff. Pursuant to 18 USC 1961(5), the court notes, a pattern "requires at least two acts of racketeering activity, one of which occurred within ten years \* \* \* after the commission of a prior act of racketeering activity."

Many courts, Chief Judge Pratt observes, have held that where the predicate acts all occurred in the course of a single scheme to defraud, a pattern of racketeering has not been established. Such an interpretation, the court indicates, is consistent with Congress' intent to exclude isolated criminal conduct from RICO liability.

Adopting this interpretation, Chief Judge Pratt holds that separate acts in furtherance of the same criminal episode do not constitute a "pattern" of racketeering activity under RICO.

Since the alleged indictable conduct in this case was all performed in furtherance of a single scheme to steal and sell plaintiff's trade secrets, the court declares, the counts of the complaint alleging a violation of RICO must be dismissed.

**Copyrights, Infringement:** A juke box operator who affixed the requisite registration certificate inside the juke box is held liable for copyright infringement. Under §116(b) of the Copyright Act, the U.S. District Court for the District of Massachusetts explains, the certificate must be affixed in a place where it is visible to the public. By way of relief, Judge Freedman awards plaintiff minimum statutory damages of \$250 for each of the nine infringements. (*Broadcast Music, Inc. v. Dugas Music Service*, 9/24/86)

**Patents, Obviousness:** The PTO Board of Patent Appeals and Interferences, in reversing an obviousness rejection, criticizes the examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice." Such an assertion is a conclusion, not a reason, the board points out. (*In re Garrett*, 9/30/86)

The claimed invention pertains to a drill string stabilizer. All the claims at issue were rejected under 35 USC 103 for obviousness. The examiner stated that:

Furthermore, wear blades having parallel sides

are notoriously well known in the prior art and one of ordinary skill in the art would, through routine engineering design choice, elect to provide a borehole contacting apparatus with blades having parallel sides.

The board reverses the rejection. Examiner-in-Chief Lindquist indicates that the examiner's statement sets forth a conclusion, not a reason.

**Intellectual Property, Supreme Court:** The Supreme Court, on November 10th, declined to review the following cases:

*Chicago Systems Software v. Evans Newton, Inc.*, No. 86-441, in which petitioner questioned the Seventh Circuit's interpretation of the "work for hire" doctrine. See 32 PTCJ 671.

*Darby Dental Co. v. Premier Dental Co.*, No. 86-480, wherein petitioner protested the Third Circuit's reading of §526 of the Tariff Act of 1930 as proscribing the unauthorized importation of any foreign-made goods bearing a domestically owned trademark. See 32 PTCJ 671.

**Government Patents, Licenses:** The Navy intends to grant Mankind Research Unlimited Inc., of Maryland, a revocable, nonassignable, limited exclusive license under the government-owned patent entitled "Cable Connector." See 51 Fed. Reg. 40063, 11/4/86.

The proposed license will be granted unless the Office of the Chief of Naval Research receives, within 60 days, written objections to the grant, along with supporting evidence establishing that the grant would not be in the public interest.

For further information, contact: Mr. R. J. Erickson, staff patent attorney, Office of the Chief of Naval Research, Code OOCPP1, Ballston Tower No. 1, 800 N. Quincy Street, Arlington, Virginia 22217-5000.

**Government Patents, Licenses:** The National Technical Information Service (NTIS) intends to grant Lehn & Fink Products Group, Sterling Drug, Inc., of Montvale, New Jersey, an exclusive license under the government-owned patent applications entitled "Cockroach Repellents." See 51 Fed. Reg. 40350, 11/6/86.

The proposed license will be granted unless NTIS receives, within 60 days, written evidence and argument establishing that the grant would not serve the public interest.

Inquiries and comments should be addressed to: Office of Federal Patent Licensing, NTIS, Box 1423, Springfield, Virginia 22151.